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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#20 Reply Brief JRM 1-7-03

APPLICANT: Cannata et al.

SERIAL NO.: 09/667,826 ART UNIT: 2878

FILED: 9/21/00 EXAMINER: Hannaher, C.

TITLE: Infrared Imaging System Employing On-Focal Plane Non-uniformity Correction

ATTORNEY DOCKET NO.: 901.0013 USU

Assistant Commissioner For Patents
Washington, D.C. 20231

Reply Brief

Sir:

This is in reply to the Examiner's Answer mailed November 1, 2002 (Paper No. 19).

In regard to the rejection under 35 U.S.C. 112, first paragraph, the Board is directed to that fact that Figs. 3B and 3C of U.S. Patent 5,811,808 (the patent seeking reissue), show all the switches 228 as being open. The detailed description describes that the switches 228 can be selectively closeable to provide respective ones of the binary offset correction coefficients (S_0-S_N). As noted on column 16, line 56 et seq.:

"The operation of the embodiment of FIG. 10 and the result achieved is substantially the same as that described above in relation to FIG. 3B. That is, in response to the binary offset correction coefficients supplied from the offset coefficient memory (shown in FIG. 1), the signals S_0-S_N are applied to switches 228 to open or close the respective switches to couple the selected constant current sources 400 into the offset correction circuit 220." (emphasis added)

It should be clear to a person skilled in the art that one of the switches might be closed while the other switches are open. What applicant is claiming, by not reciting "parallel connected" is merely the structural equivalent to this functional situation. Furthermore, Figs. 3B and 3C are merely one type of embodiment regarding the number of actual switches the correction circuit might have. This should be clearly evident from the signal S_N and, wherein N is defined in the application as a "**nonnegative integer**" (for example, see issued claims 3 and 10). The number "1" is a nonnegative integer. Thus, the application as originally filed fully supports the disclosure of N being 1.

In regard to 35 U.S.C. 251, the present application was filed within the two year period for broadening reissues. Deletion of the term "parallel connected" is not an improper recapture. The term "parallel connected" was not added to the claims during prosecution. It was in the claims as originally filed. The first examiner, in his statement of reasons for allowance merely stated:

"...the prior art of record fails to teach or fairly suggest an infrared imaging system or focal plane array having in combination with the other required elements, the means for correcting specified by independent claims ...".

The first examiner never mentioned "parallel connected" and, the means for correcting in claim 1 comprises 54 words of a total of 175 words in the entire claim (i.e., about 30% of the entire claim language). If one were also to take into account the examiner's statement "...in combination with the other required elements..." this could be interpreted as 100% of the claim language. It clearly appears that preventing about 30% of the claim language from being available for change because the examiner stated that "...the prior art of record fails to teach or fairly suggest an infrared imaging system or focal plane array having in combination with the other required elements, the means for correcting specified by independent claims ..." is unduly narrow and afforded applicant "no true notice" that such a narrow interpretation of his statement would limit the claim language in this way in the future.

If the first examiner had given better notice, then at least application could have filed a continuation or divisional patent application to not have the claim language limited in the way the new examiner is attempting to do. However, no explicitly precise language was used by the first examiner to give notice that a surrender of anything other than "parallel connected" was occurring. The first examiner merely used a general reference to the "means for correcting" in combination with the other required elements. Clearly, this is not the

situation specified in MPEP §1412.02 example C. The first examiner was making a general statement regarding the claim as a whole and, MPEP §1412.02 (page 1400-14, col. 1, lines 12-23) appear applicable, by analogy, to the facts of this case.

The facts of this case are not inappropriate recapture. The applicant was never given good and sufficient notice that applicant would be considered as "**surrendering**" non-parallel connected circuit elements. Clearly, no surrendering was envisioned, much less notice of surrender given, by the first examiner or the applicant at the time of the mailing of the notice of allowability.

In regard to the rejection of the claims based upon 35 U.S.C. §§102(b) and 103(a), Hegel, Jr. et al. does not "anticipate" any of the claims and, Hegel, Jr. et al. does not render the claims obvious. The first examiner having reviewed Hegel, Jr. et al. and allowing the claims clearly concurred that the claims were patentable over Hegel, Jr. et al. The new examiner is now rejecting previously patented claims (claims 1, 5-7, 12, 13, 15, 19, 22, 24 and 25) which the first examiner allowed. The new examiner is not using any new art for his rejection. The new examiner is merely using the same art which the first examiner had in front of him and, which the first examiner allowed the claims over.

The new examiner has indicated that he is **not** interpreting the claim language "means for separately correcting offsets" as means plus function claim language. The Board is requested to correct the new examiner's incorrect claim language interpretation. The term "means for separately correcting

offsets" is clearly means plus function claim language under 35 U.S.C. §112, sixth paragraph.

Respectfully submitted,

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